

### **REMARKS**

Applicant thanks the Examiner for withdrawing the finality of the previous rejections subsequent to filing a Notice of Appeal. Applicant notes, however, that the newly cited references are no more pertinent than those previously cited. Moreover, Applicant expects that a complete search had been previously conducted, and Applicant should therefore not be subjected to additional rejection based on newly cited references after overcoming the final rejection, particularly with documents that are no more pertinent than those previously overcome.

Claims 1-28 are pending in this application. Claims 1 and 16 have been amended. The amendments to claims 1 and 16 have been made to more clearly define the claimed subject matter. No new matter has been added to the application by any of the foregoing amendments.

#### **I. Section 102(b) Rejections**

At pages 2-3 of the Office Action, claims 1-5, 7-10, and 15 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,496,236 to Buonaiuto (hereinafter the "Buonaiuto patent"). The Action contends that Buonaiuto discloses an exercise device as claimed in the present invention including a transverse section and two upstanding sections, with an open bottom. This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 is directed to an exercise device comprising an elongate, substantially upright weight-bearing portion for supporting the weight of a user during exercising, including a transverse section and two upstanding sections extending therefrom, with the transverse section including a gripping portion extending across a top of the device. The weight-bearing portion generally lies in a first plane, with an open portion generally located in the first plane between the two upstanding sections. The user of the device may grip the gripping portion clear of interference from the feet, with the open portion defining an open frame for exercising without obstruction.

The Buonaiuto patent discloses a physical therapy apparatus having a tubular inverse U-shaped upper portion (42) including a cross-bar (34) and two depending leg portions (46). The apparatus also includes a lower portion (40) having tubular leg portions (44) extending

from base members (20) and a cross-bar member (32) securing the leg portions (44) with T-shaped pipe couplings (47). The upper portion is removably attached to a lower portion (40) using the T-shaped pipe couplings (47). *See* FIGS. 1-3; col. 3, ll. 36-46. Additionally, the Buonauto patent discloses a strut (48) that depends from cross-bar member (32) and a socket extending perpendicularly from the strut (48). An elongated rod (52) extends from the socket (49) and attaches to a chair coupling member (16). *See* FIG. 1-3; col. 4, ll. 2-12.

The Buonauto patent does not disclose, among other things, an open portion generally located in a first plane between the two upstanding sections, nor does the Buonauto patent disclose a weight-bearing portion generally lying in a first plane. The cross-bar member (32), socket (49), and tension adjusting mechanism (19), shown in Figs. 2-3, are located between the U-shaped upper portion (42) and the tubular leg portions (44). Claim 1 clearly recites an open portion generally located in a first plane between the two upstanding sections. Such structure of Buonauto interferes with the open structure defined in the claims. Furthermore, the Buonauto patent discloses an elongated rod (52) attached to panel (50), which extends perpendicularly from the rest of the structure. Such structure extending perpendicularly from the center portion of the cross-bar member (32) also interferes with the open structure. Moreover, such structure interferes with the balancing, and therefore does not meet the language of claim 1 requiring a weight-bearing portion generally lying in a first plane and a feet and weight-bearing portion being configured so that the mass of the device is generally balanced about the first plane. Since the Buonauto patent does not disclose or teach all of the limitations found in claim 1, the § 102(b) rejection based on the Buonauto patent is unsupported.

The Office Action specifically contends on page 5, paragraph 7, that "...functional recitations associated with an apparatus claims, or statements of intended use are not germane to the patentability of a device, so long as the prior art is capable of performing the recited functions". Applicant is not aware of any standard for patentability involving prior art being "capable of" performing a function, particularly where the apparatus fails to include specific claim limitations. In the present case, Buonauto fails to disclose or suggest an open portion. It is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure. *In re Mills*, 916 F.2d 680, 683, 16 USPQ2d 1430, 1433 (Fed. Cir. 1990). Since Buonauto does not describe or suggest such a claimed open framework, its "capable" function is entirely irrelevant.

Claims 2-5, 7-10, and 15 depend from claim 1, either directly or indirectly, and add further limitations to claim 1. Since claims 2-5, 7-10, and 15 include all of the limitations of claim 1, the § 102(b) rejection for these claims is also unsupported, because the Buonauto fails to teach each and every element of the claimed invention, as discussed above.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. §102(b) of claims 1-5, 7-10 and 15 be reconsidered and withdrawn.

## **II. Section 103(a) Rejections**

At page 4 of the Office Action, claims 6, 11-14, and 16-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Buonauto patent alone. This rejection is respectfully traversed.

When making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The Examiner can satisfy this burden *only* by showing an objective teaching of *all* of the claim limitations in the state of the art, or knowledge generally available to one of ordinary skill in the art, which would lead an individual to combine the relevant teachings and/or the knowledge within the state of the art in the manner suggested by the Examiner. *Id.*; *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974).

As to claims 6 and 11-14, the Office Action asserts that the Buonauto patent alone teaches all of the limitations, including the missing ones found in claim 1, but does not teach the specific sizing parameters, which the Office Action alleges to be an obvious design choice. As outlined above, the Buonauto patent alone does not teach or suggest the limitations found in claim 1. Claims 6 and 11-14 depend from claim 1, either directly or indirectly, and add further limitations to claim 1. Therefore, because dependent claims 6 and 11-14 include the limitations of independent claim 1, the § 103(a) rejection based upon the teachings of the Buonauto patent is also unsupported and does not establish a *prima facie* case of obviousness for these claims. Accordingly, Applicant requests reconsideration and withdrawal of the § 103(a) rejection of claims 6 and 11-14.

As to claims 16-28, the Office Action asserts that the Buonauto patent alone teaches the claimed invention except for a second exercise device, which the Office Action asserts is obvious to one of ordinary skill in the art. Claim 16, as amended, is directed to exercise

devices having an elongate upright weight-bearing portion generally lying in a first plane and an open portion generally located in said first plane below the gripping portion. Additionally, a pair of ground-engaging feet and the weight-bearing portion are configured so that the mass of the device is generally balanced about the first plane.

The Buonavito patent discloses a cross-bar member (32) as well as other structure located between the U-shaped upper portion (42) and the tubular leg portions (44) and does not meet the "open portion" language found in claim 16. Also, in contrast to the limitations found in claim 16, the Buonavito patent discloses an elongated rod (52) attached to panel (50) that extends perpendicularly from the apparatus, preventing the apparatus from being generally balanced about a plane and having a weight-bearing portion generally lying in a first plane. The Buonavito patent fails to teach each and every element found in claim 16. Therefore, the § 103(a) rejection based upon Buonavito alone is unsupported and does not establish a *prima facie* case of obviousness.

Claims 17-28 depend either directly or indirectly from and add further limitations to independent claim 16. Therefore, because dependent claims 17-28 include the limitations of independent claim 16, the § 103(a) rejection based upon the teachings of the Buonavito patent is also unsupported for these claims.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) of claims 16-28 be reconsidered and withdrawn.


**CONCLUSION**

For all of the foregoing reasons, Applicant submits that pending claims 1-28 are patentable over the cited prior art and in condition for allowance. Accordingly, reconsideration of the rejections and allowance of pending claims 1-28 are respectfully requested.

Should the Examiner have any questions regarding any of the foregoing or wish to discuss this application in further detail to advance prosecution, the Examiner is invited to contact Applicant's undersigned representative at the telephone number provided below.

Respectfully submitted,

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